



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

APPEAL BRIEF FOR THE APPELLANTS

MAEDA, Kazuya, et al.

**LIQUID CONTAINING BAG AND FROZEN DESSERT MANUFACTURING
APPARATUS USING THE SAME**

Serial Number: 10/519,832

Filed: **January 10, 2005**

Group Art Unit: 3744

Examiner: **TAPOLCAI, William E.**

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PATENT & TRADEMARK OFFICE

Date: September 29, 2009



**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appeal No: _____

In re the Application of: **MAEDA, Kazuya, et al.**

Group Art Unit: **3744**

Serial No.: **10/519,832**

Examiner: **TAPOLCAI, William E.**

Filed: **January 10, 2005**

P.T.O. Confirmation No.: **9645**

For: **LIQUID CONTAINING BAG AND FROZEN DESSERT MANUFACTURING
APPARATUS USING THE SAME**

BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: September 29, 2009

Sir:

This is an appeal from the Office Action dated July 6, 2009.

A Response Under 37 CFR §1.116 was filed on June 23, 2009.

An Advisory Action was mailed on July 6, 2009.

A Notice of Appeal was filed on July 24, 2009.

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the subject application, which is:

Sanyo Electronic Co., Ltd.

5-5, Keihanondori, 2-Chome, Moriguchi-Sshi

OSAKA, 570-8677, JAPAN

II. RELATED APPEALS AND INTERFERENCES

Appellants know of no other prior appeals, pending appeals, interferences, or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

* * * *

III. STATUS OF CLAIMS

Claims 6, 8, and 10 have been rejected and are the subject of this appeal.

* * * *

IV. STATUS OF AMENDMENTS

All amendments have been entered.

* * * *

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 6 on appeal recites a frozen dessert manufacturing apparatus (*see element SM in Figure 1 for one example of a frozen dessert manufacturing apparatus; see also the specification, page 7, lines 8-12*) comprising:

a cold storage (*see element 2 in Figure 1 for one example of a cold storage; see also the specification, page 7, lines 12-17*) which cold-stores a liquid containing bag (*see element 5 in Figure 1 for one example of a liquid containing bag; see also the specification, page 7, lines 12-17*) constituted of a bag main body (*see element 21 in Figure 2 for one example of a bag main body; see also the specification, page 9, lines 4-17*) containing a mixture (*see element M in Figure 2 for one example of a mixture; see also the specification, from page 9, line 24 to page 10, line 1*) and having flexibility and an outer layer member (*see element 23 in Figure 2 for one example of an outer layer member; see also the specification, page 9, lines 18-21*) disposed outside this bag main body, capable of forming a sealed space (*see space around element AI, in Figure 2, which corresponds to one example of a sealed space; see also the specification, from page 9, line 24 to page 10, line 1*) between the outer layer member and the bag main body, and having flexibility;

a cooling cylinder (*see element 8 in Figure 1 for one example of a cooling cylinder; see also the specification, page 10, lines 20-24*) which stirs and cools the mixture supplied from the liquid containing bag to thereby manufacture frozen dessert;

a cooling device (*see element 4 in Figure 1 for one example of a cooling device; see also the specification, page 7, lines 25-27*) which cools the cold storage or the cooling cylinder;

an air compression device (*see element 18 in Figure 1 for one example of an air compression device; see also the specification, page 12, lines 25-27*);

a mixture supply passage (*see element 34 in Figure 2 for one example of a mixture supply passage; see also the specification, page 10, lines 16-18*) for connecting the inside of the bag main body of the liquid containing bag to the inside of the cooling cylinder;

a bag pressurizing passage (*see element 7 in Figure 2 for one example of a bag pressurizing passage; see also the specification, page 10, lines 12-16*) for supplying compressed air produced by the air compression device between the outer layer member and the bag main body of the liquid containing bag;

an air supply passage (*see element 51 in Figure 2 for one example of an air supply passage; see also the specification, page 13, lines 15-17*) for supplying compressed air into the cooling cylinder; and

a combined passage member (*see element 57 in Figure 2 for one example of a combined passage member; see also the specification, page 14, lines 15-18*) detachably attached to the cooling cylinder and disconnectably connected to the mixture supply passage and the air supply passage,

wherein the mixture supply passage is combined with the air supply passage, and thereafter connected to the inside of the cooling cylinder by the combined passage member, and the combined passage member is disposed in the cold storage.

* * * *

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 6, 8, and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,494,055 (**Meserole '055**) in view of U.S. Patent No. 6,234,351 (**Wilcox '351**).

* * * *

VII. ARGUMENT

The rejection of claims 6, 8, and 10 on appeal is improper and should be withdrawn, for the following reasons.

A. CLAIMS 6, 8, and 10

Claims 6, 8, and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,494,055 (**Meserole '055**) in view of U.S. Patent No. 6,234,351 (**Wilcox '351**).

Appellants respectfully traverse this rejection, for the following reasons.

Meserole '055 and **Wilcox '351**, alone or in combination, fail to describe, teach, or suggest the combination of features as set forth in claim 6 including at least the following features: "a combined passage member detachably attached to the cooling cylinder and disconnectably connected to the mixture supply passage and the air supply passage, wherein the mixture supply passage is combined with the air supply passage, and thereafter connected to the inside of the cooling cylinder by the combined passage member, and the combined passage member is disposed in the cold storage," in combination with the other claimed features.

In **Meserole '055**, a bag 44 does not have bag main body containing a liquid and an outer layer member capable of forming a sealed space between the outer layer member and the bag main body.

The Examiner has acknowledged that **Meserole '055** does not disclose that the bag includes an inner layer and an outer layer with the compression device supplying the compressed air between the layers (Office Action dated March 24, 2009, page 2, paragraph 2).

In order to try to remedy the acknowledged deficiencies of **Meserole '055**, the Examiner has cited and relied on **Wilcox '351**. **Wilcox '351** discloses a multiple-ply bag 10 that is formed with an air input port 14 and an air input conduit 15 that allow air 6 from a source of pressurized air 2 to enter an inflatable air chamber formed in an interply region 204, 205 of the bag 10.

The Examiner has acknowledged that the air injection point 35 of **Meserole '055** is located outside the refrigerated mix cabinet 40 (Figure 4). The Examiner has suggested that the air injection point 35 corresponds to the “combined passage member” as set forth in claim 6 of the subject application (lines 11-15). Claim 6 of the subject application sets forth a combined passage member which is located inside a cold storage.

Appellants respectfully submit that the Examiner has improperly suggested that the location of the air injection point 35 is merely a matter of design choice. In particular, the Examiner has improperly suggested that “The location of the combined passage member 35 [air injection point 35] of **Meserole ’055** is considered to be a matter of obvious choice to one of ordinary skill in the art” (Office Action dated March 24, 2009, page 2).

The Examiner has improperly suggested that the location of the combined passage member (as set forth in claim 6 of the subject application) is merely a matter of design choice. The Examiner has improperly suggested that “The location of the combined passage member being disposed in the cold storage is considered to be a mere matter of obvious choice to one of ordinary skill in the art.” (Office Action dated March 24, 2009, page 3, lines 2-6). Appellants respectfully disagree with the Examiner's suggestions.

The Location of a combined passage member as set forth in claim 6 of the subject application is **not** a mere matter of obvious choice to one of ordinary skill in the art.

In the Office Action dated March 24, 2009, the Examiner appears to be improperly relying on information from *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). In *In re Japikse*, claims to a hydraulic power press switch which read on the prior art except with regard to the position of the starting switch were held to be unpatentable because shifting the position of the

starting switch would not have modified the operation of the device. Thus, when a change in location of a claimed element does not modify the operation of a device, such a change in location can be held to be an obvious matter of design choice.

The facts of *In re Japikse* are very different from the facts at issue regarding **Meserole '055** and claim 6 of the subject application.

Moving the air injection point 35 of **Meserole '055** into the refrigerated mix cabinet 40 would modify the operation of the device. Accordingly, in view of the above, the facts at issue regarding **Meserole '055** and claim 6 of the subject application are very different from the facts of *In re Japikse*.

The location of the combined passage member as set forth in claim 6 of the subject application is not a mere matter of obvious choice to one of ordinary skill in the art.

In **Meserole '055**, the mix travels out of the refrigerated mix cabinet 40, and then travels through the piping 46. The mix arrives at the air injection point 35 after traveling through the piping 46. The temperature of the mix will increase before arriving at the air injection point 35, because the air injection point 35 is not inside the refrigerated mix cabinet 40. Because the air injection point 35 is outside the refrigerated mix cabinet 40, this means that the air is warmer than the temperature

of the refrigerated mix cabinet 40, and this also means that the mix is warmer than it was when it was inside the refrigerated mix cabinet 40.

Changing the location of the air injection point 35 to a new location inside the refrigerated mix cabinet 40 would modify the operation of the **Meserole '055** device. If the air injection point were located inside the refrigerated mix cabinet 40, the mix and the air would be at colder temperatures when they were combined, and thus the mix and the air would combine in a different manner.

Accordingly, in view of the above, the location of the air injection point 35 is not merely a matter of obvious choice.

The Examiner must provide a motivation or reason for a worker in the art to make such a modification to the **Meserole '055** device, because the Examiner's new location for the air injection point 35 inside the refrigerated mix cabinet 40 would modify the operation of the **Meserole '055** device.

The Examiner has not demonstrated how the cited art could provide a motivation or reason for a worker in the art to change the location of the air injection point 35 of **Meserole '055** from outside the refrigerated mix cabinet 40 to inside the refrigerated mix cabinet 40.

The Examiner has not demonstrated how the cited art could describe, teach, or suggest the combination of features as set forth in claim 6 including the features relating to the location of the combined passage member inside the cold storage, in combination with the other claimed features.

A mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.

"Rejections on obviousness cannot be sustained by mere conclusory statements." *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S.Ct. 1727, 82 USPQ2d 1385.

The Board of Patent Appeals and Interferences has stated that: "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes to the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Meserole '055 and Wilcox '351, alone or in combination, fail to describe, teach, or suggest the combination of features as set forth in claim 6.

The U.S. Patent and Trademark Office has the burden of proof to show that an applicant is not entitled to a patent if the claimed subject matter is anticipated by, or is obvious from, the art of record. A patent applicant is entitled to a patent unless the U.S. Patent and Trademark Office establishes otherwise.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007) noted that the analysis supporting a rejection under 35 U.S.C. §103 should be made explicit.

The Examiner has not yet articulated how the cited art could show the combination of features as set forth in claim 6.

Meserole '055 and **Wilcox '351**, alone or in combination, fail to describe, teach, or suggest the combination of features as set forth in **claim 6** including the following features: "a combined passage member detachably attached to the cooling cylinder and disconnectably connected to the mixture supply passage and the air supply passage, wherein the mixture supply passage is combined with the air supply passage, and thereafter connected to the inside of the cooling cylinder by the combined passage member, and the combined passage member is disposed in the cold storage," in combination with the other claimed features.

Accordingly, in view of the above, Appellants respectfully submit that this rejection of claim 6 is improper and should be withdrawn. It is submitted that this rejection of claims 8 and 10 should be withdrawn by virtue of their dependency.

B. LEVEL OF SKILL IN THE ART

Appellants respectfully submit that the rejection of claims 6, 8, and 10 should be withdrawn, because of the following issues concerning a level of skill in the art.

The rejection of claims 6, 8, and 10 is based on what is within the ordinary level of skill in the art. But there are no findings, based on substantial evidence of record, regarding what is the ordinary level of skill in the pertinent art. Importantly, the Federal Circuit requires that such findings be made and that they be based on substantial evidence of record.

In *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999), the Federal Circuit overturned an obviousness rejection because of its failure to make the kind of obviousness legal analysis that the Supreme Court commanded in *Graham v. John Deere Co.*, 376 U.S. 1, 17-18 (1966). Such a legal analysis must begin, the Federal Circuit has consistently held, with making specific findings of fact regarding the level of ordinary skill in the art. Thus, the *Dembiczak* decision held that an

obviousness rejection must be reversed if, like the instant rejection, it fails to contain “specific findings of fact regarding the level of ordinary skill in the art.” 175 F.3d at 1000-01.

In addition, the findings that the U.S. Patent and Trademark Office makes on the ordinary level of skill must be supported by substantial evidence of record. *In re Kaplan*, 789 F.2d 1574, 1580 (Fed. Cir. 1986) (“Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was.”). See also *In re Mayne*, 104 F.3d 1339, 1341 (Fed. Cir. 1997) (“The foundational facts for the prima facie case of obviousness are: ... (3) the level of ordinary skill in the art.”).

Thus, the rejection of claims 6, 8, and 10 lacks findings and analysis that the Federal Circuit considers essential to support a rejection based on ordinary skill in the art. In addition, the rejection of claims 6, 8, and 10 lacks substantial evidence of record to support such findings, even if they had been made.

Accordingly, in view of the above, Appellants respectfully submit that the rejection of claims 6, 8, and 10 is improper and should be withdrawn.

C. JUSTICE

In the interest of justice and fairness, it is submitted that the rejection of claims 6, 8, and 10 should be withdrawn. Appellants respectfully submit that it is unjust, unfair, and improper for the Examiner to ignore selected remarks made in the Response filed June 23, 2009.

In the Advisory Action dated July 6, 2009, the Examiner does not respond to selected remarks which were included in the Response filed June 23, 2009, regarding this issue: moving the air injection point 35 of **Meserole '055** into the refrigerated mix cabinet 40 would modify the operation of the device, and thus the Examiner must demonstrate motivation for that modification, and the Examiner cannot make an unsupported allegation that it would be a mere matter of obvious choice.

In the Advisory Action dated July 6, 2009, the Examiner only responds to selected portions of the Appellant's remarks. The Examiner ignores and disregards other portions of the Appellant's remarks.

Accordingly, in view of the above, the rejection of claims 6, 8, and 10 is deemed unjust and unfair. Appellants respectfully submit that the rejection of claims 6, 8, and 10 is improper and should be withdrawn.

In the event this paper is not timely filed, Appellants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,
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Enclosures: Claims Appendix
Evidence Appendix
Related Proceeding Appendix

VIII. CLAIMS APPENDIX

Listing of Claims:

Claim 6 (Previously Presented): A frozen dessert manufacturing apparatus comprising:

a cold storage which cold-stores a liquid containing bag constituted of a bag main body containing a mixture and having flexibility and an outer layer member disposed outside this bag main body, capable of forming a sealed space between the outer layer member and the bag main body, and having flexibility;

a cooling cylinder which stirs and cools the mixture supplied from the liquid containing bag to thereby manufacture frozen dessert;

a cooling device which cools the cold storage or the cooling cylinder;

an air compression device;

a mixture supply passage for connecting the inside of the bag main body of the liquid containing bag to the inside of the cooling cylinder;

a bag pressurizing passage for supplying compressed air produced by the air compression device between the outer layer member and the bag main body of the liquid containing bag;

an air supply passage for supplying compressed air into the cooling cylinder; and

a combined passage member detachably attached to the cooling cylinder and disconnectably connected to the mixture supply passage and the air supply passage,

wherein the mixture supply passage is combined with the air supply passage, and thereafter connected to the inside of the cooling cylinder by the combined passage member, and the combined passage member is disposed in the cold storage.

Claim 8 (Previously Presented): The frozen dessert manufacturing apparatus according to claim 6, further comprising: check valves which are connected between the mixture supply passage and the combined passage member and between the air supply passage and the combined passage member and which are in a forward direction on the side of the combined passage member.

Claim 10 (Previously Presented): The frozen dessert manufacturing apparatus according to claim 6 or 8, wherein the mixture supply passage is disposed in the cold storage.

* * * *

IX. EVIDENCE APPENDIX

None.

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X. RELATED PROCEEDINGS APPENDIX

None.

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